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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,246

05/03/2006

Peter Dopfer

DOPF3003/JEK

8678

23364 7590 12/26/2008

BACON & THOMAS, PLLC

625 SLATERS LANE

FOURTH FLOOR

ALEXANDRIA, VA 22314-1176

EXAMINER

SEVERSON, JEREMY R

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,246	<b>Applicant(s)</b> DOPFER ET AL.	
	<b>Examiner</b> Jeremy Severson	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

The amendment to the specification submitted on 11 September 2008 is acceptable and has been entered.

### ***Claim Objections***

The claim objections are withdrawn in light of the amendments.

### ***Claim Rejections - 35 USC § 112***

The 35 USC 112 rejections are withdrawn in light of the amendments.

### ***Claim Rejections - 35 USC § 101***

The 35 USC 112 rejections are withdrawn in light of the amendments.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Minamishin (US 6,334,610).

Minamishin discloses a method for continuous sheet-by-sheet singling of stacks of loose bank notes, comprising: utilizing a singling unit (32) for singling a stack of loose sheet material; a feeding device for moving stacked loose sheet material to be singled along a feeding path from a deposit position to a position in which the uppermost sheet

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of the stacked loose sheet material can be grasped by the singling unit; and a stack inserting device (74) for moving a stack of loose sheet material to be singled along an insertion direction into the deposit position, wherein the feeding device has a first feeding element (40) being movable at least along two axes, a first axis of the axes being parallel to the feeding path and a second axis of the axes being orthogonal to both the feeding path and the insertion direction and a second feeding element (42) being uniaxially movable along the feeding path from a first position in which a stack of loose sheet material is insertable into the deposit position to a second position in which the uppermost sheet of the stack contacts the first feeding element, wherein the singled bank notes are automatically checked and deposited.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filsinger (US 5,538,238).

Re claim 1, Filsinger discloses a singling unit (col. 5, lines 43-44), a first multiaxially movable feeding element 22, a second uniaxially movable feeding element 4. Filsinger lacks the explicit disclosure of a stack inserting device for moving a stack of loose sheet material to be singled along a stack insertion direction into the deposit position. Filsinger discloses that the new sheet pile is placed beneath the residual sheet

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pile. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a stack inserting device to perform this task, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192.

Re claim 2, in Filsinger the first feeding element 22 brings, by a uniaxial feeding motion, a stack of loose sheet material to be singled from the deposit position to the position in which the uppermost sheet of the stack can be grasped by the singling unit and, by being drawn out of the feeding path, unites the stack to be singled with a stack to be fed located below the first feeding element.

Re claim 3, in Filsinger the second feeding element 4 brings, by a uniaxial motion on the feeding path, the stack to be fed from the deposit position to a position in which the uppermost sheet of the stack to be fed comes to lie below the first feeding element.

Re claim 4, in Filsinger, the first feeding element 22 assumes the position of the second feeding element 4 by traversing a loop-shaped motion path and being inserted into the feeding path, and the second feeding element returns to the deposit position for receiving a stack to be fed on the feeding path.

Re claim 5, in Filsinger the second feeding element 4 has depressions 21, and the first feeding element 22 is formed complementary so that it can engage the depressions at least partly.

Re claim 6, in Filsinger the first feeding element 22 is moved into the feeding path below the stack of loose sheet material carried by the second feeding element 4.

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Re claim 7, in Filsinger the first feeding element 22 has a deposit surface (upper surface of 22) which can be vertically shifted with respect to other components of the first feeding element. If the rods 22 are flipped over, the surface has been vertically shifted with respect to the other parts of the feeding element.

Re claim 8, Filsinger discloses a singling unit (col. 5, lines 43-44), a first multiaxially movable feeding element (comprising elements 22 and 4), and a second multiaxially movable feeding element 9, wherein the first feeding element has a deposit surface 4 with holes 21, and a plurality of opposing elements 22 which can reach through the holes.

Re claim 9, in Filsinger the deposit surface 4 with holes 21 and the opposing elements 22 can be shifted relative to each other for holding to be able to hold a stack of sheet material to be singled spaced from the deposit surface.

Re claim 10, Filsinger discloses one or more sensors which detect a stack to be fed located in the deposit position. See col. 5, lines 46-60.

Re claim 11, Filsinger discloses that the first element 22 is driven by a stationary motor 38. Filsinger does not explicitly disclose that the second element 4 is driven by a stationary motor. Filsinger discloses that the second element 4 can be displaced by driving elements. See col. 4, lines 61-67. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a stationary motor as the driving element, in order to provide an inexpensive, durable driving element.

Re claims 12, 22 and 23, Filsinger discloses performing the operations manually. See col. 5, lines 40-67. It would have been obvious to one of ordinary skill in the art at

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the time of the invention to make the operations automatic, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192.

Re claims 13-15, Filsinger discloses a method for continuously singling loose sheet material, comprising bringing a stack of loose sheet material to be singled from a deposit position to a position from which an uppermost sheet of the stack is grasped and singled by a singling unit by means of a feeding device having a first multiaxially movable feeding element 22 and a second uniaxially movable feeding element 4, further comprising (a) feeding a stack of loose sheet material to be singled located on the first feeding element to the singling unit, by a feeding motion of the first feeding element on a feeding path, from a deposit position to a position in which the uppermost sheet of the stack can be grasped by the singling unit, singling the fed stack sheet by sheet by the singling unit, the stack being fed by the feeding element such that the particular uppermost sheet of the stack can be grasped by the singling unit, (e) taking over the united stack of loose sheet material by the first feeding element, whereby the first feeding element assumes the position of the second feeding element by traversing a loop-shaped motion path and being inserted into the feeding path, and (f) returning the second feeding element to the deposit position, depositing a further stack of loose sheet material on the returned second feeding element and then feeding said further stack. See col. 5, lines 40-67.

Re claim 16, in Filsinger the traversing of the loop-shaped motion path of the first feeding element 22 consists of comprises the following steps: (h) perpendicular motion leading away from the feeding path (col. 5, lines 64-65), (i) motion parallel to the feeding path in the direction of the deposit position to a position adjacent the second feeding element (inherent in the reference because such motion is necessary to move rods 22 between steps (h) and (k)), and (k) perpendicular motion leading to the feeding path (col. 5, lines 51-56).

Re claim 17, in Filsinger the first feeding element 22 engages depressions 21 of the second feeding element 4 when being inserted into the feeding path.

Re claim 18, in Filsinger the first feeding element 22 is inserted into the feeding path below the stack of loose sheet material carried by the second feeding element 4.

Re claim 19, Filsinger discloses a method for continuously singling loose sheet material, comprising bringing a stack of loose sheet material to be singled from a deposit position to a position from which an uppermost sheet of the stack is grasped and singled by a singling unit by means of a feeding device having a first multiaxially movable feeding element (comprising elements 9 and 22) and a second uniaxially movable feeding element 4, wherein a deposit surface 22 of the first feeding element is rotated and/or opened and/or horizontally and/or vertically shifted with respect to other components 9 of the first feeding element.

Re claims 20 and 21, in Filsinger a plurality of opposing elements 22 of a first feeding element (comprising elements 9 and 22) reach through holes 21 of a deposit



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surface 4 of the first feeding element 4 to hold a stack of sheet material to be singled to provide a substantially closed deposit surface.

### ***Response to Arguments***

Applicant's arguments filed 11 September 2008 have been fully considered but they are not persuasive.

Applicant argues that Filsinger does not teach an apparatus movable along at least two axes, wherein a first axis is parallel to the feeding path and a second axis is orthogonal to both the feeding path and the insertion direction. The examiner respectfully disagrees. Element 22 of Filsinger is movable along two axes, both parallel to the feeding direction (as it is being pulled out/pushed in to the holes 21), and perpendicular to the feeding direction (as it is raised up and down by lift 8).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy Severson whose telephone number is (571)272-2209. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeremy Severson/  
Examiner, Art Unit 3653

/Patrick H. Mackey/  
Supervisory Patent Examiner, Art  
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